

S/N 09/961,024

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Brian R. Mears et al.

Examiner: Nimesh Patel

Serial No.: 09/961,024

Group Art Unit: 2112

Filed: September 21, 2001

Docket: 884.481US1

Title: MULTIPLE CHANNEL INTERFACE FOR COMMUNICATIONS BETWEEN DEVICES

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Alexandria, VA 22313-1450

The applicants request review of the final rejection dated 12 January 2006 in the above-identified application. No amendments are being filed with this request. The applicant respectfully traverses all rejections under 35 USC § 103(a). This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated below:

A. Claims 1-14, 16-18, 28-31, 33-34, 36-44, and 49 were rejected under 35 USC § 103(a) as being unpatentable over Baker (U.S. 6,333,938) in view of Earnest (U.S. 6,226,338). The applicants respectfully traverse.

The MPEP requires a suggestion and a reasonable expectation of success for a rejection under 35 USC § 103.<sup>1</sup> A Federal Circuit opinion states that the suggestion or motivation to combine references and the reasonable expectation of success must both be found in the prior art.<sup>2</sup> The Federal Circuit has emphasized the need for the PTO to furnish evidence in support of claim rejections under 35 USC § 103 in *In re Lee*:

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.....The factual inquiry whether to combine references must be thorough and searching....It must be based on objective evidence of record.”<sup>3</sup>

The final Office Action has not shown evidence from the prior art of a suggestion to one skilled in the art to combine Baker and Earnest, and has not shown evidence of a reasonable

<sup>1</sup> MPEP 2143.

<sup>2</sup> MPEP 2143 citing *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

expectation of success.

The final Office Action states:

“Baker does not specifically disclose a stop message channel coupled to the receive control block and adapted to send a stop message to a source when a receive FIFO reaches a stop threshold value....it would have been obvious to include the stop message channel, as disclosed by Earnest, in the system of Baker, since this would prevent the writing of data in FIFO that has no more room for data.”<sup>4</sup>

Similar statements are made in other parts of the rejection.<sup>5</sup> The final Office Action has not identified prior art as being the source of the above-quoted rationale for combining Baker and the buffer of Earnest as is required by MPEP 2143. The devices and methods described in Baker are specifically directed to extracting control information from packetized data in an IEEE 1394 standard or similar PCI interface device.<sup>6</sup> The final Office Action has not shown why a skilled person would be motivated to modify the system of Baker that complies with IEEE 1394. The final Office Action has not shown evidence that the system of Baker that is compliant with IEEE 1394 is deficient in a way that can be remedied by addition of the “FULL” flag of the receive FIFO 18 of Earnest.

The Advisory Action dated 3 April 2006 stated the source of the above-quoted rationale for combining Baker and the buffer of Earnest is “knowledge generally available to one of ordinary skill in the art.” The applicants respectfully submit that even if the rationale is not found in the applied references, the final Office Action must show that the rationale came from the prior art with some other evidence to satisfy in *In re Lee* and *In re Vaeck*.

The final Office Action also lacks evidence from the prior art of a reasonable expectation of success of this combination of Baker and Earnest as required by MPEP 2143. The final Office Action has not mentioned this element of a *prima facie* case of obviousness.

The final Office Action states:

“Official Notice is being taken that advantages of power management are well known in the art and it would have been obvious to include a power management unit in the system of Baker since this would allow power to be saved.”<sup>7</sup>

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<sup>3</sup> *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

<sup>4</sup> Final Office Action, page 3.

<sup>5</sup> Final Office Action, pages 6-7, 8, and 10-11.

<sup>6</sup> Baker, column 3, lines 5-11.

<sup>7</sup> Final Office Action, page 4.

The applicants respectfully traverse this assertion of official notice. Official notice is taken of supposed “advantages of power management.” The final Office Action appears to be taking official notice of the scope and content of the prior art, or is taking official notice that a claimed feature is obvious. In either case, official notice cannot be used to establish the scope and content of the prior art, or the obviousness of a claimed feature. Obviousness can only be established by showing all of the elements in MPEP 2143.

Official notice should only be used where the facts asserted are capable of instant and unquestionable demonstration:

“the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute.’”<sup>8</sup>

The “state of the art” is not an appropriate subject of official notice:

“[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amendable to the taking of such notice.”<sup>9</sup>

Official notice should rarely be used in a final Office Action:

“While ‘official notice’ may be relied on, these circumstances should be rare when an application is under final rejection.”<sup>10</sup>

MPEP 2144.03 cites both *In re Zurko* and *In re Lee* requiring that rejections be based on evidence of record.<sup>11</sup>

The Advisory Action dated 3 April 2006 indicated that the applicant’s failure to traverse the examiner’s assertion of official notice means that the “statement is taken to be admitted prior art.” Nowhere does the MPEP say that an applicant loses the right to traverse an improper taking of official notice. The Advisory Action lists four new references purporting to be evidence of the notoriety of power management and the round robin algorithm. These references are not relevant to the rejection until they are applied under the requirements of 35 USC §103, and the applicants make no representations regarding these references. The applicants respectfully submit that this

<sup>8</sup> MPEP 2144.03 quoting *In re Ahlert*, 165 USPQ 418, 420 (CCPA 1970).

<sup>9</sup> MPEP 2144.03 quoting *In re Eynde*, 178 USPQ 470, 474 (CCPA 1973).

<sup>10</sup> MPEP 2144.03

<sup>11</sup> *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001); *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002).

is another attempt to reject pending claims under §103 using official notice to avoid the requirements of §103.

The applicants respectfully submit that the official notice taken in the final Office Action is improper under MPEP 2144.03, should be withdrawn, and that the affected claims are in condition for allowance.

The rejection of claim 34 establishes that Baker is missing the “round-robin” feature, but does not point to any prior art with the feature. None of the elements of a *prima facie* case of obviousness of MPEP 2143 are established in this rejection. The applicants respectfully request that a prior art reference be added to the rejection showing the features missing in Baker, or that the rejection of claim 34 be withdrawn. The references listed in the Advisory Action dated 3 April 2006 are not applied under §103 and are irrelevant until properly applied in a formal rejection.

The applicants respectfully submit that a *prima facie* case of obviousness against claims 1-14, 16-18, 28-31, 33-34, 36-44, and 49 has not been established in the final Office Action, and that claims 1-14, 16-18, 28-31, 33-34, 36-44, and 49 are in condition for allowance.

B. Claim 35 was rejected under 35 USC § 103(a) as being unpatentable over Baker, in view of Earnest and Holm et al. (U.S. 6,122,680, Holm). The applicants respectfully traverse.

The final Office Action has not identified prior art as being the source of the stated rationale for combining Baker, Earnest, and Holm as is required by MPEP 2143. The final Office Action has not presented prior art showing a reasonable expectation of success of such an arrangement. The applicants respectfully submit that a *prima facie* case of obviousness against claim 35 has not been established in the final Office Action, and that claim 35 is in condition for allowance.

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**CONCLUSION**

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at (612) 373-6973 to discuss any questions which may remain with respect to the present application.

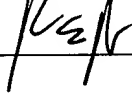
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

BRIAN R. MEARS ET AL.

By their Representatives,

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Date 12 April 2006 By   
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12th day of April, 2006.

Name Amy Moriarty

Signature 